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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of

MILLER, DAVID

Serial No: 09/696,376

Filed: 25 October 2000

For: PROGRAMMABLE SELF-OPERATING
COMPACT DISK DUPLICATION SYSTEM

Examiner: HUBER, P.

Art Unit: 2651

Paper No: 7

Atty Dkt.: 13240(A)

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March 19, 2002

By Sally Whitsett

Sir:

**PETITION AND FEE UNDER 37 C.F.R. §1.91 FOR CONSIDERATION
OF EXHIBITS ACCOMPANYING DECLARATIONS UNDER
37 C.F.R. §1.131 TO OVERCOME CITED PUBLICATION AND
RESPONSE TO EXAMINER ACTION AND PETITION
FOR EXTENSION OF TIME UNDER §37 C.F.R. §1.136(a)**

Applicant respectfully petitions for a two (2) month extension under 37 C.F.R. §1.136(a) to and including March 19, 2002 for response to the Examiner Action dated October 19, 2001. An extension fee in the amount of \$200.00 is included in the submitted payment of \$330.00 to cover the extension fee.

Applicant further petitions for consideration of Exhibits under 37 C.F.R. §1.91 which accompany the declaration of David Miller, inventor of the subject matter of the parent Application, Serial No. 08/816,257, the issued Patent No. 6,141,298, and this divisional application from Patent No. 6,141,298; and, the

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declaration of Umberto Cettomai who reviewed the first showing of the device that was the subject of the originally filed application, Serial No. 08/816,257, filed March 13, 1997. The fax copy of Cettomai is of poor quality and is attached to an unsigned copy for clarity. A petition fee in the amount of \$130.00 included in the payment of \$330.00 to cover the exhibit entry fee under 37 C.F.R. §1.131.

Applicant respectfully requests that the Examiner consider the submitted declarations and exhibits and re-examine the claims in view of the submissions and the following remarks.

REMARKS

The Patent and Trademark Office Action dated October 19, 2001 has been carefully considered.

Claims 1-20 are pending in this application. Applicant requests that the claims be reviewed in view of the submitted declarations and exhibits, and the remarks here presented. A supplemental Information Disclosure Statement is being submitted under separate cover.

With regard to the Examiner's rejection of the claims under 35 U.S.C. §102(a) as anticipated by the publication of K. Cochrane "Automated CD-R Recording Duplication or Replication?", the Applicant traverses the rejection by Rule 37 C.F.R. §1.131 Affidavit.

Applicant, WordTech Systems, is assignee of the inventor, David Miller. The CopyPro 5000 unit disclosed in the referenced publication, circa, June 6, 1996, is a reference to Miller's own invention. The device disclosed, identified as the CopyPro 5000, was originally identified as the CopyPro CD-R 4000. Shortly after introduction, prior to the circa June 6, 1996 publication, the device disclosed was

identified as the CopyPro CD-R 5000. The facts supporting this submission are set forth in the supporting declaration of David Miller, accompanying this re-examination request.

Applicant, WordTech Systems, assignee of David Miller, holds the ownership of the invention and CopyPro, Inc. was authorized to manufacture and distribute the product prior to the June 6, 1996 date. (Declaration of Miller, ¶¶3-4).

With regard to the obviousness rejection of the claims under 35 U.S.C §103(a) as unpatentable over the publication of K. Cochrane "Automated CD-R Recording Duplication or Replication?" considered with Lee et al, U.S. Patent No. 5,914,918, Applicant takes issue on the following grounds.

1. The declaration of David Miller establishes prior invention over the referenced publication.

2. The combination of Lee et al with the disclosure of the MTC Trans/corder in the referenced publication is not suggested

With regard to the first ground, the inventor's declaration clearly establishes an invention and reduction to practice prior to the effective date of the June 6, 1996 publication. From the limited content of the disclosure there is no manner of determining how the MTC device operated. Although two doors and two spindles are apparent from the photo depiction of the MTC Trans/corder, the mechanism for moving disks from one spindle to the other is not discernable.

Even if it were disclosed that a rotary tower with a picker mechanism were being used (which is not disclosed), there is no suggestion for combining the MTC Trans/corder with the carousel and elevator tower of Lee. While there is always motivation for "more bigger, better, faster," how this is achieved is the cornerstone of invention.

There is no suggestion in either reference as to how the combination should be made and which components from which device are to be kept or discarded. For example, a rotary carousel of spindles in combination with a linear tower having a pick mechanism might be the off-spring of such a mating. The proposed modification should not change the principle operation. In Re Ratti: 270 F.2d 810, 123 USPQ 348 (CCPA 1959).

Additionally, even if a robotic disk changer having a pivotal robot arm as taught in Dennis, U.S. Patent No. 5,291,465, were considered, the mechanics of adding a series of vertical stations for placement and retrieval of disks in combination with the pivotal motion of the arm is a daunting engineering task that is clearly not obvious. For example, a modification of the Dennis mechanism (which at least is shown in some detail) to adapt to a set of multiple stacked players requires a complete redesign of the cam lift mechanism. Even if the photo and description of the MTC Trans/corder were clear, and the device were available for reverse engineering, it is still unlikely that Applicant's claimed apparatus would be obvious.

In conclusion, it is respectfully requested that the Examiner consider the petition to admit the Exhibits, and review the accompanying affidavits with a view toward allowance.

To assist in the Examiner's review, Applicant would request that an interview be scheduled to further discuss the merits of the Examiner's Action and the Applicant's response.

Dated: March 19 2002

Respectfully submitted,


RICHARD ESTY PETERSON
Registration # 26,495

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March 19, 2002

By

Sally Whitsett

Sir:

**DECLARATION UNDER 37 C.F.R. §1.131 IN SUPPORT OF REDUCTION
TO PRACTICE OF ROTARY TOWER DISK DUPLICATION SYSTEM
PRIOR TO JUNE 6, 1996**

I, Umberto Cettomai, declare and state:

1. I am the president of Alea Systems, Inc., a company that develops and markets disk recording technology for multi-drive, compact disk recording systems. My experience with robotic disk duplication systems enables me to understand the operation of such systems when demonstrated.
2. I attended the CeBIT international trade show held in Hanover, Germany on March 14-20, 1996.
3. At the trade show I met with David Miller from CopyPro, Inc., a company that had a booth at the trade show for display and demonstration of disk

4. Mr. Miller showed me the CopyPro CD Duplication System at the trade show and demonstrated its operation.

5. The CopyPro CD Duplication System shown and demonstrated to me at the trade show was a desktop unit with multiple disk spindles and with multiple CD recorder drives. The unit had a vertically moving disk pickhead on a rotating tower. The rotating tower allowed selective picking of a disk from the extended disk tray of any one of the stacked disk drives or from the disk spindles in the radius of the pickhead. The picked disk could then be transported to any other spindle or extended tray in the radius of the pickhead. The unit shown and demonstrated to me at the CeBIT trade show is depicted in the flier entitled "CopyPro CD-R 4000" attached to this declaration as Exhibit A.

5. The CopyPro CD Duplication System shown and demonstrated to me at the trade show was a desktop unit with multiple disk spindles and with multiple CD recorder drives. The unit had a vertically moving disk pickhead on a rotating tower. The rotating tower allowed selective picking of a disk from the extended disk tray of any one of the stacked disk drives or from the disk spindles in the radius of the pickhead. The picked disk could then be transported to any other spindle or extended tray in the radius of the pickhead. The unit shown and demonstrated to me at the CeBIT trade show is depicted in the flier entitled "CopyPro CD-R 4000" attached to this declaration as Exhibit A.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the referenced application of David Miller or any patent issued thereon. /

Dated: _____

Umberto Cettomai

CopyPro CD-R 4000™

Automatic CD-R Autoloader

The CD-R 4000 provides for unattended duplication of CD-R media.

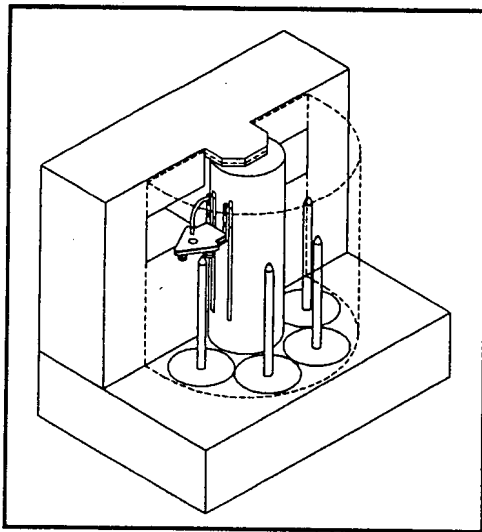


Exhibit A

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Expandable Architecture

The CD-R 4000's expandable "CD-R drive array" lets you add additional CD-R drives for fast duplication of large production runs.

- High capacity / fast duplication
- High volume CD-R duplication
- Supports multiple CD-R drives
- Unattended operation

Multi-Drive CD-R Solution

The CD-R 4000's multi-drive capability lets you match production capability to your current needs. As your needs grow, additional CD-R drives can be added for faster duplication throughput. Plus as CD-R technologies changes, the CD-R 4000 will be able to support the new drive types used for high-density CD-R media.

- Automatic / unattended operation
- 450 disk input/output magazines
- Rated for 100% duty cycle
- Expandable CD-R drive array
- Easy to use

Specifications

- 450 CD-R media capacity input and output magazine
- Supports industry standard CD-R media and future high-density media
- Compatible with high speed CD-R drives
- Autoloader cycle time: 4 seconds
- Includes CD-R software
- Weight: 50 lbs.
- Dimensions: 16"H X 17"W X 24"D
- Power: 100/240 VAC 50/60HZ

CD-R 4000 models

Single-Drive \$19,995

Dual-Drive \$29,995

Quad-Drive \$39,995

Additional CD-R Drives:

Module with 2 drives \$9,995

Note: A CD-R 4000 can support a total of 14 CD-R drives (up to 7 modules)

Your investment in a CopyPro is protected with unlimited technical support, and a one year factory warranty.

1-800-887-9906

CopyPro Inc., 1590 Solano Way, Suite C,
Concord, CA 94520 USA

Tel: (510) 689-1695 Fax: (510) 689-1263

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March 19, 2002

By Sally Whitsett

Sir:

DECLARATION OF DAVID MILLER UNDER 37 C.F.R. §1.131
IN SUPPORT OF REDUCTION TO PRACTICE OF
ROTARY TOWER DISK DUPLICATION SYSTEM
PRIOR TO JUNE 6, 1996

I, David Miller, declare and state:

1. I am the inventor of the subject matter of U.S. Patent Application Serial No. 08/816,257, filed March 13, 1997 entitled Programmable Self-Operating Compact Disk Duplication System.

2. I am also the inventor of the subject matter of U.S. Patent Application Serial No. 09/152,815, filed September 14, 1998 of the same title, which application has issued as U.S. Patent No. 6,141,298 on October 13, 2000. This application and this issued patent is a continuation-in-part of my earlier application No. 08/816,257, now abandoned. The continuation-in-part application

issuing as Patent No. 6, 141,298 is identical to the originally filed application with the exception of Figures 5A and 5D which were added to the continuation-in-part application to detail the preferred printer for use in the disk duplication system disclosed.

3. Applicant WordTech Systems, Inc., a California corporation is wholly owned and controlled by me. WordTech Systems, Inc. has its principal place of business at 4020 Pike Lane, Concord, California 94520. This corporation owns certain technologies and rights to intellectual property including the technology of issued U.S. Patent No. 6,141,298 and the subject application 09/696,376, filed October 25, 2000, which is a divisional of the application issuing as the '298 patent.

4. I also own and control CopyPro, Inc., a California corporation having its principal place of business at 4020 Pike Lane, Concord, California 94520. CopyPro, Inc. is the authorized manufacturing company that manufactures and distributes technology products for WordTech Systems, Inc., including the CopyPro CD-R 4000 and CD-R 5000.

5. The first public display of the programmable self-operating compact disk duplication system described in Application No. 08/816,257 (the '257 application) was at the CeBIT Trade Show in Hannover, Germany.

6. The Trade Show commenced on March 14, 1996 and continued to March 20, 1996. The U.S.A. Pavilion is a certified program of the U.S. Department of Commerce.

7. Attached as Exhibit 1 are copies of a CopyPro, Inc. purchase order dated 12/21/95 for an exhibit booth at the CeBIT Trade Show; a CeBIT information

cover sheet; a statement from the Hannover Fairs USA, Inc. handing the Trade Show booking; and a marked-up copy of booth availability provided by Hannover Fairs USA.

8. Exhibit 2 is a copy of the official CeBIT 96 show brochure for the Trade Show in Hannover, Germany from March 14-20, 1996. The brochure lists the U.S.A. exhibitors at CeBIT Hannover. CopyPro, Inc. was not listed because of the late registration of CopyPro.

9. The rotary tower auto loader that was the subject of the original '257 application was identified as the CopyPro CD-R 4000, and one of the original brochures describing the CopyPro CD-R 4000 is attached as Exhibit 3.

10. At the CeBIT Trade Show I spent the morning of the opening of the show on March 14, 1996 setting up counters that were sufficient to support the new CopyPro CD-R 4000 Autoloader. Prior to March 14, 1996 the Autoloader was sealed in its shipping container and not viewable by the public.

11. During the Trade Show the CopyPro CD-R 4000 Autoloader was on public display and was viewed by the general public. I operated and demonstrated the CopyPro CD-R 4000 Autoloader to interested attendees at the Trade Show.

12. Many people viewed the operation of the CopyPro CD-R 4000 Autoloader including Umberto Cettomai, President of ALEA Systems, Inc., Annapolis Junction, Maryland, and David Suden of the Rimage Corporation, Minneapolis, Minnesota.

13. The CeBIT Trade Show of March 14, 1996 was the first time that the CopyPro CD-R 4000 was shown and offered for sale.

14. On March 20, 1996, I repacked the CopyPro CD-R 4000 Autoloader into its shipping container and removed it from the hall, returning it to my office in Concord, California.

15. Since March 14, 1996, the CopyPro CD-R 4000, as disclosed in the '257 application and shown and operated at the CeBIT Trade Show, has been offered for sale and sold in the United States.

16. Prior to the RepliTech Trade Show in June of 1996, the model name of the CopyPro CD-R 4000 was changed to the CopyPro CD-R 5000.

17. The CopyPro 5000 disclosed in the publication of K. Cochrane, "Automated CD-R Recording, Duplication or Replication?" circa June 6, 1996 is the same device as the CopyPro CD-R 4000 shown at the CeBIT Trade Show in March of 1996.

18. My practice in constructing a demonstration prototype to be offered at an international trade show is to develop an operable prototype from a schematic layout.

19. Exhibit 4 is a layout of the rotary tower and spindle stations together with the location of the recorder stacks created under my direction. The file creation log accompanying the drawing establishes that this drawing was created on December 12, 1995.

20. Mechanical drawings for various parts of the production model of the autoloader unit were created under my direction and are set forth in Exhibit 5.

21. The drawings in Exhibit 5 were created prior to the RepliTech Trade Show on or about June 6, 1996.

22. Each of the drawings in Exhibits 4 and 5 was created under my

direction and the copied drawings attached as exhibits are true copies of the drawings for the CopyPro CD-R 4000 and CD-R 5000 created prior to June 6, 1996 on the dates specified on the drawings.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the referenced application of David Miller or any patent issued thereon.

Dated: MARCH 18, 2002


David Miller